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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	: ShaoHui et al.
Serial No.	: 10/707,768
Filed	: January 9, 2004
For	: Magnetic Resonance Imaging Magnetic Field Generator
Group Art No.	: 2859
Examiner	: Shrivastav, B.

CERTIFICATION UNDER 37 CFR 1.8(a) and 1.10

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37 CFR 1.8(a) **37 CFR 1.10**

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PETITION UNDER 37 C.F.R. §1.144 SEEKING SUPERVISORY REVIEW OF RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the Restriction Requirement made Final January 11, 2005, Applicant requests supervisory review and consideration of the following remarks in support of the rejoinder of claims 1-22.

REMARKS

In the Office Action mailed October 8, 2004, the Examiner imposed a three-way restriction of claims 1-22. The Examiner identified Group I consisting of claims 1-8 drawn to a magnetic field generator assembly including a plurality of magnetic elements and classified by the Examiner in class 335, subclass 296. Group II, consisting of claims 9-15, was identified as drawn to a magnetic resonance imaging apparatus classified in class 324, subclass 31. Group III, consisting of claims 16-22, was identified as drawn to a method of manufacturing a magnet element assembly for an MRI apparatus classified in class 29, subclass 602.1. In response, Applicant filed a timely Election and Response on November 8, 2004, in which Group I was elected with traverse. Despite Applicant's arguments, the Examiner made the Restriction final, and withdrew claims 9-22 from consideration in the Office Action mailed January 11, 2005.

In the Restriction Requirement of October 8, 2004, the Examiner stated that Groups I and II were related as subcombination and combination. The Examiner further stated that Group II, the combination, does not require the particulars of Group I, the subcombination, "because the combination can have an electromagnet or a single magnet to generate required (sic) magnetic field." In addition, the Examiner stated that Group I, the subcombination, "has separate utility such as use in magnetic resonance spectrometers." Responsive thereto, Applicant detailed the similarity and interrelation between the claim elements in Groups I and II, and showed that the Examiner did not satisfy the requirements necessary for proving distinctness.

In summary, Applicant showed that the restriction requirement could not be sustained because the elements of the claims of Groups I and II are interrelated. Specifically, Applicant noted that claim 1 of Group I calls for "a plurality of magnetic elements configured to collectively generate a magnetic field," and claim 9 of Group II calls for a "magnetic assembly include[ing] at least one multi-element magnet." Additionally, claim 1 of Group I calls for "a non-magnetizable pane," and claim 9 of Group II calls for "at least one non-magnetizable sheet." The interrelationship between these claims is self-evident, and one of ordinary skill in the art would readily recognize the similarity between these alleged groups.

Applicant also argued that the Examiner's statement asserting that the apparatus of Group II could utilize an electromagnet did not support the proffered restriction requirement. Such a statement does not prove that the combination (Group II) does not require the particulars of the subcombination (Group I), as is required by MPEP §806.05(c). If, as the Examiner asserted, the

scope the claims of Group II encompasses an electromagnet, the Examiner did not explain why the scope of the claims of Group I does not also encompass an electromagnet. In particular, since the claims of Groups I and II have been shown to be clearly interrelated, the Examiner failed to show why an electromagnet falls within the scope of claim 9, but not claim 1.

Likewise, the Examiner's statement that the apparatus of Group II could utilize a "single magnet" does not show how the combination does not require the particulars of the subcombination. If by "single magnet," the Examiner meant a magnet with one magnetic element, then the example does not fit within the scope of either Group I or Group II, as both claim 1 and claim 9 call for multiple magnetic elements. If, however, "single magnet" was intended to mean one multi-element magnet, then such example could fall within the scope of both claims 1 and 9. Therefore, the Examiner did not show that the "combination as claimed does not set forth the details of the subcombination as separately claimed." MPEP §806.05(c). Since restriction under MPEP §806.05(c) requires two-way distinctness, and since the Examiner has failed the first requirement for showing distinctness, the restriction between Group I and Group II must be withdrawn and these claims rejoined.

Applicant further argued that the Examiner's proffered example of separate utility of Group I does not support distinctness since it does not show that Group I has "acquired a separate status in the art because of [its] divergent subject matter," as the Examiner claimed. The Examiner stated that Group I "has separate utility such as use in magnetic resonance spectrometers." However, Group II was classified by the Examiner in class 324, subclass 318. This classification is designated as "Spectrometer components." Thus, Group I does not have separate utility divergent from the subject matter of Group II, and the scope of a proper search for Group I would overlap a proper search for Group II.

Accordingly, the restriction of Group I and Group II cannot be sustained under MPEP §806.05(c) and claims 1-8 and 9-15 must be rejoined. The claims of Groups I and II have interrelated elements and the Examiner did not prove that that the combination (Group II) does not require the particulars of the subcombination (Group I) or that the subcombination has separate utility.

In regard to Group I and Group III, the Examiner indicated that the groups "are related as process of making and product made." In support of this, the Examiner stated that "[i]n the instant case, the product as claimed can be an electromagnet or a single magnet made of magnetic material, which is made by a different process." However, Applicant showed that the Examiner's

position with respect to Group I and Group III is directly contradictory to the Examiner's position with respect to Group I and Group II. Further, the Examiner never described the "different" process, and did not apply the correct test. The correct test is whether the product can be made by a "materially different process". MPEP §806.05(f).

Applicant noted that the Examiner directly contradicted the restriction between Group I and Group II, by stating that Group I could encompass an electromagnet or a single magnet. In the restriction between Groups I and II, the Examiner had indicated that an electromagnet and a single magnet would not fall within the scope of the claims of Group I. Then, as a basis for restriction between Groups I and Group III, the Examiner stated that an electromagnet or single magnet would fall within the scope of Group I. This contradiction demonstrates the inadequacy of the restriction.

Even ignoring the inconsistency, the restriction between Groups I and III was unsupported since the proffered examples to prove distinctness were inapplicable. If, as the Examiner asserted, an electromagnet or a single magnet falls within the scope of Group I, the Examiner failed to show how or why they would not fall within the scope of Group III. Specifically, claim 1 in Group I calls for "a plurality of magnetic elements configured to collectively generate a magnetic field," and claim 16 of Group III calls for the step of "assembling a plurality of magnetic elements to form a multi-element magnet." The Examiner failed to show that the products falling within the scope of Group I can be made by a process materially different than that of Group III, and did not attempt to show that the process of Group III can be used to make other and materially different products.

In order to sustain the proffered restriction, MPEP §806.05(f) requires an Examiner to prove either "(1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process." However, rather than meeting this requirement, the Examiner summarily concluded that "[i]n the instant case, the product as claimed can be an electromagnet or a single magnet made of magnetic material, which is made by a different process." This conclusory statement in no way shows *how* the product could be made by a materially different process, as required by MPEP §806.05(f). Furthermore, the Examiner did not propose any process at all, materially different or otherwise.

Further, the Examiner failed to establish the necessary requirements for proving distinctness. Accordingly, the restriction of Group I and Group III cannot be sustained under MPEP §806.05(f) and claims 1-8 and 16-22 must be rejoined.

Regarding Group II and Group III, the Examiner indicated that the groups are related as process of making (Group III) and product made (Group II). In support of this, the Examiner first stated that "the product could be made by another and materially different process." Thereafter, the Examiner summarily concluded that "the product as claimed can be a single magnet or an electromagnet, which is made by different processe[s]." The Examiner did not provide any support for either conclusion. As such, Applicant again argued that the Examiner failed to substantiate the proffered conclusions by using a single magnet or an electromagnet as an example.

If an electromagnet or a single magnet falls within the scope of Group II, the Examiner did not show how such would not fall within the scope of Group III. Specifically, claim 9 of Group II calls for, in part, a magnetic assembly which includes "at least one multi-element magnet." Likewise, claim 16 of Group III calls for the step of "assembling a plurality of magnetic elements to form a multi-element magnet." Thus, an examination of the elements of the claims of Group II and Group III evidences a clear interrelation therebetween. The Examiner did not explain how two claims, both reciting "multi-element magnet", could have such a different scope that the product (Group II) could be made by another and materially different process (Group III). Additionally, as before, the Examiner did not attempt to show that the process (Group III) could be used to make other and materially different products which fall outside the scope of Group II.

Therefore, Applicant showed that restriction was not proper between any of the identified claim groups because the requirements of MPEP §§ 806.05(c) and (f) had not been satisfied. However, in the Office Action of January 11, 2005, the Examiner expressed disagreement with Applicant's remarks regarding restriction between Group I and Group II and between Group I and Group III. The Examiner did find Applicant's remarks with regard to rejoinder of Groups II and III persuasive and withdrew the restriction as between those non-elected groups.

With regard to maintaining the restriction between Group I and Group II, the Examiner stated that:

> "the limitation 'a non-magnetizable panc operationally connected to **limit separation of one magnet element from another magnetic element**' found in

> claim 1 (Group I) is not found in claim 9 (Group II). Therefore, ... the combination (Group I) does not include all of the limitations of the subcombination (Group II), as claim 9 and claim 10 respectively include "connection" and "adhesive" in their limitations. But these limitations are neither functionally equivalent nor inherent to the claimed separation limiting Group I." (Emphasis in original.)

Not only is this basis for restriction entirely separate from that originally set forth in the Office Action of October 8, 2004, it too is insufficient to support a requirement for restriction. According to MPEP §806.05(g), to prove distinctness between a combination and a subcombination, the Examiner must show both that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. MPEP §806.05(c). The Examiner's above-quoted basis for restriction purports to recite only an example of an element found in the subcombination that is not in the combination -- that is the basis of any combination-subcombination. This does not establish the requisite two-way distinctness. *Id.*

Regardless, in an Amendment submitted with Applicant's Response to the Office Action of January 11, 2005, Applicant deleted the phrase "operationally connected to limit separation of one magnetic element from another magnetic element" from claim 1. Therefore, the Examiner's new basis for restriction is no longer applicable. Specifically, the element of Group I, the subcombination, which was allegedly not required in Group II, the combination, is no longer called for in claim 1. Applicant therefore requests that Groups I and II be rejoined.

In regard to the restriction between Group I and Group III, the Examiner has already acknowledged that Groups II and III are not restrictable. Therefore, if Groups I and II are also not properly restrictable, neither are Groups I and III.

It also appears that the Examiner proffered both a new type of and basis for restriction between Groups I and III. In the original Restriction of October 8, 2004, the Examiner stated that Group I and Group III are related as process of making and product made. However, in the Office Action of January 11, 2005, the Examiner stated that Group I and Group III are related as subcombination and combination. In fact, it appears as though the Examiner's remarks in regard to Groups I and III in the Office Action of January 11, 2005, were merely copied from the remarks regarding Group I and Group II. In relying on the assertion that claim 1 of Group I contained a limitation not found in claim 16 of Group III (i.e. that the non-magnetizable part was operationally connected "to limit separation..."), the Examiner stated that claims 9 and 10

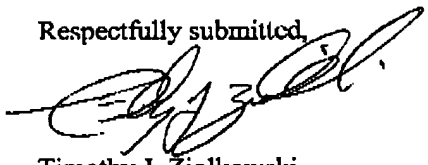
"include 'connection' and 'adhesive' in their limitations." While Applicant sees no apparent relevancy between a discussion of claims 9 and 10 of Group II, and a restriction between Groups I and III, as explained above, the limitation used to support the Examiner's basis for restriction has been removed. Therefore, Applicant requests that Groups I and III be rejoined.

In summary, the Examiner did not provide a valid basis for restricting between Groups I, II, and III in the Restriction of October 8, 2004. Specifically, Applicant showed that the Examiner failed to establish the necessary criteria of MPEP §§ 806.05(c) and (f). Furthermore, an examination of the elements of the claims of each Group shows that the original Restriction was based merely on the preambles of the independent claims, rather than upon a consideration of the claim elements and all the claims in each group as a whole. Then, in the Office Action of January 11, 2005, the Examiner provided new and inadequate basis for restriction between Groups I and II, and Groups I and III. Despite the fact that the newly proffered basis for restriction did not establish the two-way distinctness required by MPEP §806.05(c). Additionally, Applicant amended claim 1 to remove the claim limitation relied upon by the Examiner. Therefore, Applicant believes that no valid basis for restriction has been presented.

For at least these reasons, Applicant respectfully requests that the restriction be withdrawn. Accordingly, Applicant respectfully requests rejoinder of all claims.

Applicant hereby authorizes charging of deposit account no. 07-0845 for the fee of $130.00 associated with the filing of this Petition.

Respectfully submitted,



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